

## **REMARKS**

The present Amendment is in response to the Office Action dated August 19, 2004 in reference to the above-identified application. The Examiner set a shortened statutory period for reply of three (3) months, making the present Amendment due by November 19, 2004. Filed concurrently herewith is a request for a two-month extension of time so that the present Amendment is due by January 19, 2005.

In that Office Action, claims 1-19 were pending. Of these, claims 1, 5, 6, 11 and 12 were rejected over U.S. Patent No. 4,325,230 to Driscoll et al under 35 U.S.C. § 102(b). Claims 1, 11 and 12 were rejected as anticipated under 35 U.S.C. § 102(b) by a purported printed publication in the form of a print out from an internet website designated by the Examiner as "Large Cooling Stones" (hereinafter "Vance"). Claims 5, 6 and 14 were rejected under 35 U.S.C. § 103(a) as obvious over Vance taken alone. Claims 2-4, 7 and 15 were rejected as obvious under 35 U.S.C. § 103(a) over Vance in view of U.S. Patent No. 4,081,024 to Rush et al. Claims 8-10 were rejected as obvious under 35 U.S.C. § 103(a) over either Vance or Driscoll et al in view of a 1997 publication "Bartending for Dummies" (hereinafter "Foley"). Claim 13 was rejected as obvious under 35 U.S.C. § 103(a) over either Vance or Driscoll et al in view of U.S. Patent No. 2,334,941 to Linden. Claim 16 was rejected as obvious under 35 U.S.C. § 103(a) over U.S. Patent No. 4,266,941 to Harris in view of Vance and Foley. Claim 17 was rejected as obvious under 35 U.S.C. § 103(a) over Harris in view of Vance and Foley and in further view of Linden. Claims 18 and 19 were rejected as obvious under 35 U.S.C. § 103(a) over Harris in view of Vance and Foley and in further view of Rush et al.

Claim 4 was also objected to for failing to further limit the subject matter claimed. Claim 17 was rejected under 35 U.S.C. § 112, second paragraph, in that the Examiner believed it unclear what the phrase “of a common size” meant.

At the outset, the Applicants appreciate the thoroughness of the Office Action. Such clarity facilitates the identification of the issues to be addressed in this response. However, before addressing the substantive rejections, Applicants raise a preliminary issue of whether the reference to Vance, “Large Cooling Stones” is available as a printed publication under 35 U.S.C. § 102(b) or under 35 U.S.C. § 103(a). It is Applicants’ position that the Vance reference is undated and therefore cannot be applied as a basis of rejection.

Specifically, Vance “Large Cooling Stones” appears to be a print-out of information from a website, [www.halfbakery.com](http://www.halfbakery.com); **this print-out itself is not dated**. Rather, the print-out ostensibly to a subject matter, “Flavorless stones cool your beverage”, and a letter or comment from someone named “Vance” which communication is attributed the date of February 6, 2001. While Applicants do not dispute *for purposes of this response only* that information available on the internet may qualify as a printed publication, they do contend that, in order for the Examiner to establish a *prima facie* case of either anticipation or obviousness as a printed publication, such information must have been available to the public more than one year prior to the date of Applicants’ application.

Applicants’ non-provisional application was filed on November 26, 2003 and claimed an effective date of November 27, 2002 arising from the filing of a provisional application on that date. Therefore, a printed publication must have been available to the public prior to November 27, 2001 to be prior art.

There is simply no way to tell that the Vance reference was printed or available on the internet before November 27, 2001. While Vance's comment, "This can be done using current technology," is attributed to the date of February 6, 2001, there is no date on the printed reference supplied by the Examiner.<sup>1</sup> Indeed, the last entry of this print-out "Large Cooling Stones" is dated November 12, 2003 which implies that date of this print-out could not possibly be before November 12, 2003, well after the November 27, 2001 and even only about two weeks before the actual filing date of Applicants' non-provisional application.

Accordingly, Applicants respectfully request that the Examiner reconsider this reference and withdraw all rejections based thereon. The Federal Circuit has expressed the law that a person who wishes to characterize information as a "printed publication" must provide proof of its dissemination or availability and accessibility to persons concerned with the art to which the document relates. *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986). Absent such showing, this reference should not be used in rejecting any claim of the present application.

In this Amendment, Applicants have represented claim 2 in independent form by incorporating the recitations of claim 2 into claim 1. Claim 2 is therefore canceled. Claim 1 now recites that the method involves placing "at least one mass of nonporous igneous rock ... in a selected environment ... ." This language was rejected (as former claim 2) over Vance in view of Rush. Assuming, *arguendo*, that Vance is available as a reference, the Examiner admits that Vance "fails to disclose that said rock is non-porous igneous rock, specifically granite, and has a heat capacity of about 10.6 calories/degree/ mole." *Office Action, paragraph 8*. The Examiner employs Rush et al to supply this teaching. Here, Applicants believe that

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<sup>1</sup> This same analysis applies to all other comments contained within the Vance "Large Cooling Stones" reference.

the Examiner has relied on hindsight reasoning base on the teachings of the present application.

It is well settled that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure. *In re Vaeck, supra*. That is, it is improper to use hindsight reconstruction of the claimed invention using the Applicant's structure as a template. *In re Gorman*, 18 U.S.P.Q. 2d 1885 (Fed. Cir. 1991). The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. *Ex parte Clapp*, 227 U.S.P.Q. 972 (Bd. Pat. App. & Inter. 1985) ("to support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.").

While Applicants agree that Rush et al teaches that granite is a high thermal capacity material, nothing in Rush et al suggests that it could be used to cool a beverage. The material in Rush et al is taught as a medium for use in a heat exchange apparatus. Vance fails to suggest that any cooling stone either should be a nonporous igneous rock (claim 1) or should have the recited heat capacity (claim 15). Indeed, Vance seems to teach away from using a stone to cool a beverage when it states, "So the rock will only provide 8C times its specific heat capacity, which won't provide much cooling." Moreover, Rush et al does not appear to set forth the heat capacity of any material disclosed therein.

Dependent claim 4 has been canceled which removes the previous objection to the same.

With respect to dependent claim 10, nothing in any prior art reference cited by the Examiner discloses the step of controlling the manner in which a liquid beverage is cooled by sequentially adding a plurality of masses. The Examiner offhandedly takes “official notice” that it is known to place ice cubes one at a time into a vessel containing a beverage is “old and well known”. This position does not take into account that even where ice cubes are placed in a beverage, an equilibrium will be established at the melting point of ice (about 32 degrees F) so that temperature is controlled in the same manner.

Turning now to the claims for a kit (claims 16-19 and newly added claim 20), the Examiner rejected claims 16-19 over combinations of Harris in view of Vance and Foley (claim 16) and in further view of Linden (claim 17) or Rush et al (claims 18 and 19). Again, assuming, *arguendo*, that Vance may form any basis of rejection, such combinations do not fully and fairly disclose the kit recited in claim 17. Harris simply discloses an ice cube tray. Nothing is suggested that it may form the foundation of a kit for a non-porous material that is in a solid state at a temperature of about 72° F which specifically excludes water taught by Harris. Nor does any other reference remotely suggest that cooling masses that are solid at 72° F are to be positioned in a container as part of a kit. Here, again, the Examiner has impermissibly resorted to teachings of the present application to reject these claims.

Nonetheless, Applicants have amended claim 16 to recite that the masses are “nonporous igneous rock”. Further, claim 16 has been amended to include the former recitations of claim 17 directed to the relative dimension of the polyhedral masses to the vessel. Nothing in the prior art teaches or suggests any combination in a kit having this relationship. Accordingly, claims 17 and 18 have been canceled.

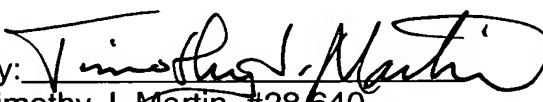
The remaining claims 16, 19 and 20 should further be allowed for the reasons advanced with respect to amended claim 1.

No additional claims fees are believed to be payable upon the Amendment. However, the Commissioner is hereby authorized to charge any deficiency in the required fees, or to credit any overpayment, to deposit account number 13-1940.

Based on the foregoing, Applicants submit that the present application is in complete condition for allowance, and action to that end is courteously solicited. If any issues remain to be resolved prior to the granting of this application, the Examiner is requested to contact the undersigned attorney for the Applicant at the telephone number listed below.

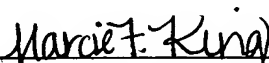
Respectfully submitted,

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**CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8**

I hereby certify that the foregoing **AMENDMENT (11 pages)**, and **REQUEST FOR A TWO-MONTH EXTENSION OF TIME (2 pages) and CHECK NO. 18684 IN THE AMOUNT OF \$225.00** is being deposited with the United States Postal Service as first-class mail in an envelope addressed to Mail Stop Non Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 19<sup>th</sup> day of January, 2005.

  
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Marcie F. King